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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400



PATENT APPLICATION

ATTORNEY DOCKET NO. 200208780-1

Inventor(s): Benjamin et al.

Application No.: 10/827,163

Filing Date: 04/19/2004

Confirmation No.: 2669

Examiner: Martin, Laura E.

Group Art Unit: 2853

Title: Fluid Ejection Device

Mail Stop Amendment  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment  
☐ New fee as calculated below  
☒ No additional fee  
☐ Other \_\_\_\_\_

- ☐ Petition to extend time to respond  
☐ Supplemental Declaration

Fee\$ \_\_\_\_\_

| CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY                            |   |   |  |  |             |                           |
|---|---|---|--|--|-------------|---------------------------|
| (1)<br>FOR  | (2)<br>CLAIMS REMAINING<br>AFTER AMENDMENT  | (3)<br>NUMBER<br>EXTRA                      | (4)<br>HIGHEST NUMBER<br>PREVIOUSLY PAID FOR | (5)<br>PRESENT<br>EXTRA                      | (6)<br>RATE | (7)<br>ADDITIONAL<br>FEES |
| TOTAL<br>CLAIMS   | 96  | MINUS                                       | 96   | = 0  | X \$50      | \$ 0                      |
| INDEP.<br>CLAIMS  | 14  | MINUS                                       | 14   | = 0  | X \$200     | \$ 0                      |
| <input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM |   |   |  |  | + \$360     | \$ 0                      |
| EXTENSION<br>FEE  | <input type="checkbox"/> 1st Month<br>\$120 | <input type="checkbox"/> 2nd Month<br>\$450 | <input type="checkbox"/> 3rd Month<br>\$1020 | <input type="checkbox"/> 4th Month<br>\$1590 |             | \$ 0                      |
| OTHER FEES  |   |   |  |  |             | \$                        |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT                                   |   |   |  |  |             | \$ 0                      |

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit: 09/30/06

Typed Name: JoAnn Sismilich

Signature:

Respectfully submitted,

Benjamin et al

By

Robert C. Sismilich

Attorney/Agent for Applicant(s)

Reg No. : 41314

Date: 9/30/06

Telephone : (858) 547-9803



HP Docket No. 200208780-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|               |                        |   |
|---------------|------------------------|---|
| Appl. No.     | :10/827,163            | ) |
| Conf. No.     | :2669                  | ) |
| Applicant     | :Benjamin et al.       | ) |
| Filed         | :04/19/2004            | ) |
| Title         | :Fluid Ejection Device | ) |
|               |                        | ) |
|               |                        | ) |
| TC / Art Unit | :2853                  | ) |
| Examiner      | :Martin, Laura E.      | ) |
|               |                        | ) |
| Docket No.    | :200208780-1           | ) |
| Customer No.  | :022879                | ) |

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

The Office Action dated 09/13/2006 has been carefully considered. In response thereto, please enter the following election and consider the following remarks.

**ELECTION**

The Office states that the claims are directed to patentably distinct species, to wit, Species I through XIV, and requires election of a single one of these species for prosecution on the merits, and a listing of all claims readable on the elected species.

In response to the election of species requirement, Applicants elect Species III, which

discloses firing cells, a fire line, and an address generator, for prosecution on the merits. Claims 23-45 are readable on Species III.

This election is made with traverse.

First, as is provided in 35 USC §121, restriction to one of two or more claimed inventions is proper only if the inventions are “independent and distinct.” Furthermore, as is stated in MPEP §809.04(h), “[i]n making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other”. However, the Office has stated in this regard only that “[t]he species are independent or distinct because each species presents a unique embodiment, creating a burdensome search” (Office Action, p.3). Applicants do not believe that a burdensome search alone serves as a valid basis for a determination that the species are independent and distinct, and thus respectfully believe the election of species requirement is deficient.

Second, in the interests of equity and fairness, Applicants should be entitled to pursue multiple sets of independent claims in the present application, so as to fully protect the disclosed invention. If the election of species requirement is maintained in its present form, Applicant will need to bear the costs associated with pursuing fourteen (14) different patent applications in order to protect the present invention.

However, Applicants acknowledge that examining together all of the claims in the present application may be burdensome. Accordingly, Applicants respectfully propose an alternate definition of species which, if acceptable to the Office, would both reduce the search burden, and at the same time be more fair and equitable to Applicants. The proposed species are as follows:

- Species I: discloses signal pulses, and generating address signals to enable firing cells. (Proposed Species I encompasses the existing Species I, IV, and V.)
- Species II: discloses fluid ejecting means, receiving a control signal, and responding to the control signal to initiate a sequence to enable the fluid ejecting means for activation.